

REMARKS/ARGUMENTS

In the Official Action, restriction was required as between Claims 1, 2, 15, 16, designated as Species I; Claims 1, 3, 15, 16, designated as Species II; Claims 1, 4, 5, 10, 15, 16, designated as Species III; 1, 6, 7, 10, 15, 16, designated as species IV; Claims 1, 8, 10, 15, 16 designated as Species V; Claims 1, 9, 10, 15, 16 designated as Species VI; Claims 1, 11-13, 15, 16 designated as Species VII; and Claims 1, 14, 15, 16 designated as Species VIII.

This restriction requirement is respectfully traversed.

Election of Species Under Traverse

In response, as a formality merely to comply with §818.03(b), Applicants hereby preliminarily elect Claims 1, 3, 15, and 16 designated as sepcies II, for an examination on the merits.

Arguments in Support of Traversal of Restriction

As a first point, the Office Action has not given any reason why the supposed "species" are considered to be patentably distinct. Without any supporting reasons, it is not Applicants' burden to show they are not distinct. Likewise it is not incumbent upon Applicants to admit that subgroups of claims are obvious variants of other groups of claims. The features are not obvious unless the Office Action cites prior art showing that dependent features are obvious in view of the cited prior art.

It is Applicants' position that in fact each of the claims are drawn essentially to a single embodiment (see, FIG. 1 of the present patent application) defining the same essential features and are not drawn to separate species. This fact should be clear merely from the Office Action, page 3, paragraph 3 wherein each of the currently pending independent Claims is listed as the generic claims. In fact, it is only by the features of the dependent claims that the Office Action has distinguished amongst the cited groups on page 2, paragraph 1. Each of the dependent claims in fact are drawn to methods (Claims 1-14) determining clusters of an image.

The MPEP in § 806.03 makes clear that (emphasis provided) "[w]here the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required." The MPEP goes on further to state the motivation for the above requirement is "because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition."

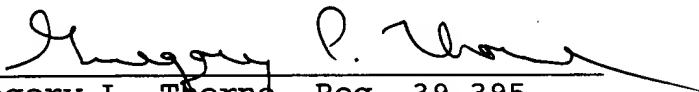
The MPEP in §803 makes clear that a restriction between patentably distinct inventions is only proper if the inventions are independent or distinct as claimed and **there is a serious burden on the examiner if a restriction is not required**. A serious burden on the examiner is prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search (see, further MPEP

§808.02). However, where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." Yet, the Office Action has done no more than to state that they are separate and distinct without any suitable showing or explanation for this distinction except to show how each claim is a refinement of the independent claim. The specifics of whether clusters are split, added, marked, etc. should not be the basis for the restriction requirement.

Accordingly, it is respectfully requested that the restriction requirement be withdrawn and that the claims be examined on the merits. In the event that this restriction requirement is upheld, it is respectfully requested that it be restated in a non-final form with support for the requirement so that the Applicants may address that support in a subsequent response.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

By 
Gregory L. Thorne, Reg. 39,395
Senior Patent Counsel
(914) 333-9665

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By Edna Chapin